

Response to Advisory Action
Serial No. 09/933,864
Page 2

REMARKS

The following remarks are fully responsive to the Advisory Action set forth above. This Response places the application in condition for allowance, or in better position for appeal, and entry of this Response and reconsideration of the application is requested.

No claims are amended or added. After entry of this Response, claims 1-8, 10-25, 27-34, and 37-61 are pending. The Examiner has indicated the allowability of claims 1-8, 10-25, 27-34, and 37-52.

Claim Rejections – Nonstatutory Double-Patenting

In a prior Office Action of September 24, 2003, the Examiner withdrew all rejections over the art of record. The Examiner rejected claims 53-61 under the judicially created doctrine of obviousness-type double patenting, as unpatentable over several allowed claims from U.S. Application 09/933,884 of Hayakawa, *et al.*, assigned to Kodak Polychrome Graphics LLC (the assignee of the present application).

The rejection is respectfully traversed. All previously allowed claims from U.S. Application 09/933,884 were cancelled (including all claims relied upon by the Examiner for the double-patenting rejection) by an Amendment Accompanying Request for Continued Examination, filed November 21, 2003.

Pending Claims in Application 09/933,884

U.S. Application 09/933,884 was filed on the same day as the present application, August 21, 2001. By the Amendment Accompanying Request for Continued Examination filed on November 21, 2003, all pending claims were cancelled. A copy of the Amendment Accompanying Request for Continued Examination filed in U.S. Application 09/933,884 was attached to the most recent Response filed in the present case, submitted November 21, 2003.

By the Amendment Accompanying Request for Continued Examination, new claims 47-98 were added, including independent claims 47, 76, 96, and 97. Claim 47 is directed to an imageable composition comprising an acid curable composition, an acid generator, and a colorant, wherein the colorant includes a counter anion derived from a non-volatile acid.

Response to Advisory Action
Serial No. 09/933,864
Page 3

Claim 76 is directed to an imageable element comprising a substrate and an imageable coating on a surface of the substrate, the coating comprising an acid curable composition, an acid generator and a colorant, wherein the colorant includes a counter anion derived from a non-volatile acid.

Claim 96 is directed to a method of making an imageable element including a substrate and an imageable coating on the substrate. The imageable coating is made from an imageable composition comprising an acid curable composition, an acid generator, and a colorant, wherein the colorant includes a counter anion derived from a non-volatile acid.

Claim 97 is directed to a method of producing an imaged element. The imaged element is made from a thermally imageable element having thermally imageable coating comprising an acid curable composition, an acid generator, and a colorant, wherein the colorant includes a counter anion derived from a non-volatile acid.

Pending Claims 53-61

The Examiner rejected claims 53-61 of the present application. Claims 53-61 (including independent claims 53, 59, and 61) were added to the present application by an Amendment filed June 20, 2003.

Claim 53 is directed to an imageable composition comprising an acid curable composition, an acid generator, a strong acid, and an infrared absorber or photothermal converter.

Claim 59 is directed to an imageable element comprising a substrate and an imageable composition coated on a surface of said substrate, said composition comprising an acid curable composition, an acid generator, a strong acid, and an infrared absorber or photothermal converter.

Claim 61 is directed to an imageable composition comprising an acid curable composition, an acid generator, and a sulfonic acid having a pKa of not more than about 8.

Each of claims 53-61 includes an acid curable composition and either a strong acid, or a sulfonic acid having a pKa of not more than about 8. A claim featuring the combination of an acid curable composition and a strong acid, or a sulfonic acid having a pKa of not more than about 8, is not unpatentable in view of any pending claim from U.S. Application 09/933,884.

Response to Advisory Action
Serial No. 09/933,864
Page 4

All pending claims from U.S. Application 09/933,884 recite the combination of an acid curable composition and a colorant having a counter anion derived from a non-volatile acid. The combination of an acid curable composition and a colorant having a counter anion derived from a non-volatile acid does not teach or suggest a combination of an acid curable composition and a strong acid or a sulfonic acid having a pKa of not more than about 8.

Applicants therefore submit that the present claims 53-61 are not obvious in view of any pending claim of U.S. Application 09/933,884. Withdrawal of the rejection is requested.

Conclusion

This Response places the application in condition for allowance, or in better position for appeal, and entry of this Response and reconsideration of the application is requested. All pending claims are now in condition for allowance. A notice to that effect is respectfully requested.

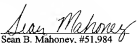
If any outstanding issues remain after consideration of this Response, the Examiner is invited to call the undersigned attorney at the number given below.

Dated: February 17, 2004

Respectfully Submitted,

NEIL FREDERICK HALEY et al.

By:


Sean B. Mahoney, #51,984
FAEGRE & BENSON LLP
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-3901
612/766-6845

MC200603335.01